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APPLICATION NO. FILING DATE		ILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,232	•	01/16/2002	Helmut Schwab	2001-1882A	3440
513	7590	11/03/2003		EXAMI	NER
	-	ND & PONACK,	FRONDA, CHRISTIAN L		
2033 K STREET N. W. SUITE 800				ART UNIT	PAPER NUMBER
WASHINGTON, DC 20006-1021				1652	
				DATE MAILED: 11/03/2003	1

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)					
Office Action Summany	10/046,232	SCHWAB ET AL.					
Office Action Summary	Examiner	Art Unit					
	Christian L Fronda	1652					
The MAILING DATE of this communication app Period for Reply	pears on the cover sheet w	ith the correspondence address					
A SHORTENED STATUTORY PERIOD FOR REPL THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a repl - If NO period for reply is specified above, the maximum statutory period - Failure to reply within the set or extended period for reply will, by statute - Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).  Status	136(a). In no event, however, may a ly within the statutory minimum of thir will apply and will expire SIX (6) MON a, cause the application to become Al	reply be timely filed ty (30) days will be considered timely. NTHS from the mailing date of this communication. BANDONED (35 U.S.C. § 133).					
1) Responsive to communication(s) filed on	<u> </u>						
2a) This action is <b>FINAL</b> . 2b)⊠ Th	nis action is non-final.						
3) Since this application is in condition for allows closed in accordance with the practice under <b>Disposition of Claims</b>							
4)⊠ Claim(s) <u>1-11,13-15 and 17-19</u> is/are pending	in the application.						
4a) Of the above claim(s) is/are withdra							
5) Claim(s) is/are allowed.							
6) Claim(s) is/are rejected.							
7) Claim(s) is/are objected to.							
8) Claim(s) <u>1-11, 13-15, 17-19</u> are subject to rest	triction and/or election req	uirement.					
Application Papers	·						
9) The specification is objected to by the Examine	er.						
10)☐ The drawing(s) filed on is/are: a)☐ acce	pted or b) objected to by t	the Examiner.					
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).							
11)☐ The proposed drawing correction filed on is: a)☐ approved b)☐ disapproved by the Examiner.							
If approved, corrected drawings are required in reply to this Office action.							
12)☐ The oath or declaration is objected to by the Ex	caminer.						
Priority under 35 U.S.C. §§ 119 and 120							
13) Acknowledgment is made of a claim for foreign	n priority under 35 U.S.C.	§ 119(a)-(d) or (f).					
a) ☐ All b) ☐ Some * c) ☐ None of:							
1. Certified copies of the priority document	ts have been received.						
2. Certified copies of the priority document	ts have been received in A	Application No					
Copies of the certified copies of the prio application from the International Bu     See the attached detailed Office action for a list	reau (PCT Rule 17.2(a)).	•					
14) Acknowledgment is made of a claim for domest	•						
a) ☐ The translation of the foreign language pro	ovisional application has b	een received.					
Attachment(s)	no priority under 55 0.5.0.	. 33 120 ana/or 121.					
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s)	5) Notice of	Summary (PTO-413) Paper No(s) Informal Patent Application (PTO-152)					

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## **DETAILED ACTION**

## Election/Restriction

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, drawn to a DNA sequence coding for hydroxynitrile lyase, classified in class 536, subclass 23.2.
  - II. Claims 7-11, 13-15, and 18, drawn to a recombinant hydroxynitrile lyase, classified in class 435, subclass 232.
  - III. Claims 17 and 19, drawn to a process for preparing (R)- or (S)-cyanohydrins by reacting aliphatic, aromatic or heteroaromatic aldehydes and ketones with a protein, classified in class 435, subclass 128.
- 2. The inventions are distinct, each from the other because of the following reasons:
  Inventions of Groups I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Each of the products of Groups I and II are independent chemical entities and require different literature searches.

Inventions (I/II) and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as using the hydroxynitrile lyase of DNA encoding thereof in a process for producing antibodies to said hydroxynitrile lyase.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. This application contains claims directed to more than one independent and patentably distinct nucleotide and amino acid sequences.

If any of Groups I-III is elected, then applicants must elect **only one sequence** selected from SEQ ID NOS: 19-24 for examination.

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Should applicant traverse on the ground that the nucleotide and amino acid sequences are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the nucleotide and amino acid sequences to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

- 4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
- 5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).
- 6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L. Fronda whose telephone number is (703)305-1252. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703)308-3804. The fax phone number for this Group is (703)308-0294. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703)308-0196.

**CLF** 

PONNATHAPU ACHUTAMURTHY SUPERVISORY PATENT EXAMINER TECHNOLOGY CENTER 1600